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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,469	03/01/2004	Mark Deem	020979-001910US	2103

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EXAMINER
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EREZO, DARWIN P

ART UNIT	PAPER NUMBER
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3773

MAIL DATE	DELIVERY MODE
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10/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/791,469

Applicant(s)

DEEM ET AL.

Examiner

Darwin P. Erez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 26-32 and 42-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 33-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/19/04, 10/4/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on 7/19/07 is acknowledged.
2. Claims 26-32 and 42-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/19/07.

### ***Information Disclosure Statement***

3. The information disclosure statements (IDS) submitted on 4/19/04 and 10/4/04 have been received and made of record. Note the acknowledged forms PTO-1449 enclosed herewith.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 9-13, 15-25, 33-36 and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,360,443 to Barone et al.

Barone discloses a stent-graft device comprising at least one stent member **166** comprising a balloon expandable stent member (Figs. 1-3) and at least one tubular graft member **160** coupled to the stent member; wherein the tubular graft has a main graft member with a skirt portion and at least two legs (see Fig. 7); wherein the leg members are fully capable of conforming to the shape of the blood vessel, including sinusoidal or helical; wherein the free ends of leg members have stent members (anchoring members) **192** attached thereto via suture wires; wherein the leg members are fully capable of being removed from the main graft members; wherein the stent anchoring members can be used at any location of the vascular system.

6. Claim 41 is rejected under 35 U.S.C. 102(e) as being anticipated by US 7,160,318 to Greenberg et al.

Greenberg discloses a kit system comprising a stent-graft device **10**; a positioning device shown in Fig. 8, and instructions (col. 11, line 2).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 2-7, 14 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barone et al., as applied to the claims above, and in further view of US 6,168,621 to Vrba.

Barone discloses all the limitations of the claims except for the stent member comprising both a self-expanding stent member and a balloon-expandable stent member. However, Vrba discloses a stent having both a self-expanding stent member and a balloon expandable stent member. This configuration is provided to allow immediate expansion of the stent member upon release, which will aid in placement of the stent during release but prior to using a balloon (col. 2, lines 4-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the stent member of Barone to include both self-expanding and balloon-expandable stent members because it would allow the stent member to expand immediately upon release to position the stent in the right location prior to the expansion of a balloon, which would fully expand the entire stent member.

Vrba further discloses that the self-expanding stent members and the balloon-expanding stent members can be arranged in alternating sequence (col. 2, lines 50-55); wherein the stent member is made of nitinol (col. 2, line 7).

Vrba is silent with regards to the stent member being formed from stainless steel or to how the self-expanding stent members or the balloon-expanding stent members are connected to each other. However, the examiner takes Official notice that the use

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of stainless steel in medical devices, especially stents, are extremely well-known, and that connecting stent portions via welding, adhesive, soldering are also well-known in the art (as evidenced by US 5,843,176; col. 3, lines 49-57). Therefore, such modifications would be obvious to one of ordinary skill in the art.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barone et al. in view of Vrba, and in further view of US 6,945,994 to Austin et al.

The above combination of Barone/Vrba discloses all the limitation of the claim except for the stent member having diamond-shaped members. However, Austin discloses a similar type of stent as Vrba, wherein the stent has both self-expanding and balloon-expandable stent members, and wherein the stent can have diamond-shaped, rectangular or even square patterns (col. 5, line 62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Barone/Vrba to include diamond-shaped stent members because Austin discloses that it is well known in the art for stents to have various shapes, including diamond-shapes.

### ***Conclusion***

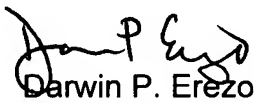
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who whose telephone number is (571) 272-4695. The examiner can normally be reached on M-F (8:00-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Darwin P. Erez  
Examiner  
Art Unit 3731

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